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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/630,563	08/02/2000	Keiichi Nakajima	PM 271791 NI-0006PCTUS	9970
909	7590	02/28/2005	EXAMINER	
PILLSBURY WINTHROP, LLP P.O. BOX 10500 MCLEAN, VA 22102			POND, ROBERT M	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 02/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/630,563

Applicant(s)

NAKAJIMA, KEIICHI

Examiner

Robert M. Pond

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

The Applicant filed an After Final Amendment and amended Claims 1, 3, 20, 27, 28, and 29 and newly added Claims 30-35. All pending claims (1-35) were examined in this final Office Action necessitated by amendment.

Response to Arguments

Premature Finality

Applicant's arguments, see Remarks, filed 03 August 2004, with respect to the rejection(s) of claim(s) 1-29 under 35 USC 103(a) have been fully considered and are persuasive.

Rejection under 35 USC 103(a)

Applicant's arguments relying upon amended claims, see Remarks, filed 03 August 2004, with respect to the rejection(s) of claim(s) 1-35 under 35 USC 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Mobile Commerce and PR Newswire as necessitated by amendment. Please note rationale. The Applicant submitted arguments in an After Final reply pertaining to premature finality based on new grounds of rejection pertaining to claims entered 02 February 2004. The Examiner found these arguments persuasive, however, the Applicant significantly amended

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independent claims and newly added Claims 30-35 in the After Final reply thereby compelling the Examiner to issue a final office action necessitated by amendment.

PR Newswire discloses US 5,724,424 (Gifford) and ties it to the Assignee. It is proper to rely upon specific disclosures cited in Gifford. Adding Gifford in the rejection statement is redundant.

Mobile Commerce and PR Newswire teach a paying terminal allowing the user to input information (please note: the buyer's computing device-wireless phone, computer terminal), settlement apparatus that synchronizes communication (please note: payment computer managing settlement with access to settlement database), billing terminal (please note: merchant computer that puts the payment instruction together is serving as the billing terminal), and further teach registered users (please note: referred to as subscribers by Mobile Commerce).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 1. Claims 1-11, 15, 17-18, and 20-35 are rejected under 35 USC 103(a) as being unpatentable over Mobile Commerce (a collection of prior art cited in Paper #7, PTO-892, Items: U-V), in view of PR Newswire (Paper #7, PTO-892, Item: X).**

Mobile Commerce teaches the Wireless Application Protocol (WAP) initiative to converge Internet content and wireless standards to support mobile commerce, specifying how Internet content and advanced telephony services can be accessed on digital cellular phones, pagers, and other wireless devices. Mobile Commerce teaches mobile commerce as the delivery of electronic commerce capabilities direct to the consumer's mobile phone- turning the cellular phone into an electronic purse handling cash, loyalty points, tickets, and identification, thereby transforming phones into virtual retail outlets in the pockets of customers. Mobile Commerce teaches a Cellnet service allowing mobile customers, who have Barclaycard credit cards, to obtain statement and other information on the phone's screen (Item: U, pages 1-2). Mobile Commerce further teaches:

- Global Mobile Commerce Industry Forum as a not-for-profit industry body investigating integrating payment systems with mobile telecommunications (Item: U, pages 1-2; Item: V, page 2); using a personal identification number (PIN) as confirmation, authorizing secure payments or transfers to other accounts, pay bills, or check balances (Item: U, page 2),
- Brokat's X-SMS Banking services providing security features to allow users to authorize transactions by typing instructions on the phone's keypad (Item: U, page 2),
- users accessing records and banking processes via electronic signatures (Item: U, page 2),
- SIM2 cards storing basic subscriber data and support for transaction processing carried out by accessing a screen-based menu for filling out transfer details or requesting information (please note examiner's interpretation: a registered user) (Item: U, page 2),
- integration of phones and smart cards or electronic purses (Item: V, page 2),
- multifunctional mobile products –Nokia Communicator, and the Alcatel One Touch Com combining GSM phone, personal organizer, and Internet e-mail client (Item: U, page 2),

Mobile Commerce teaches all the above as noted under the 103(a) rejection and teaches the Global Mobile Commerce Industry Forum investigating

integrating payment systems with mobile telecommunications, but does not disclose specifics on payment systems. PR Newswire teaches Open Market receiving US Patent 5,724,424 (hereinafter referred to as "Gifford" previously cited in Paper #7). PR Newswire teaches Gifford covering secure, real-time payment using credit and debit cards over the Internet. PR Newswire further teaches Transact 4 as a core technology in Gifford (Item: X, pages 1-2). PR Newswire teaches a system and method for purchasing goods or information over a network, the network payment system comprising purchase request, billing, payment authorization, and settlement, and use of smart cards by the payer to effect purchase and payment transactions. PR Newswire further teaches a) digital advertisements from merchants conveying price and product descriptions, b) purchase requests, c) a payment order (please note: merchant system is billing the buyer) comprising a sender, a beneficiary, a payment amount, and transaction identifiers (please note: payment server manages settlement with access to settlement database), and d) authentication based on electronic delivery address or network address (Gifford: see at least abstract; Fig. 1 (68); Fig. 12 (52-60); Fig. 14 (79-92); Fig. 15 (93-94); Fig. 16 (95-102); col. 1, line 5 through col. 3, line 59; col. 7, line 39 through col. 12, line 6). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Mobile Commerce to include payment, settlement, and billing systems as taught by PR Newswire, in order to provide

mobile commerce customers with comparable online services available to hard-wired users.

Mobile Commerce teaches all the above as noted under the 103(a) rejection but does not disclose transaction identifiers. PR Newswire teaches all the above as noted under the 103(a) rejection and further teaches a) a billing identifier for the purchase transaction, b) a unique transaction identifier used only once, and c) the payment system generating a transaction identifier comprising a random password attached to a network address, sending the identifier to the customer, and the customer returning the identifier to the payment system with the payment order for processing (Gifford: see at least abstract; Fig. 4 (13, 14, 17); col. 2, line 54-58; col. 5, lines 29-44; col. 11, lines 8-21). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Mobile Commerce to include transaction identifiers as taught by PR Newswire, in order to distinguish one transaction from another, and thereby be able to at least track and bill a customer for a given purchase transaction.

2. **Claims 12-14 are rejected under 35 USC 103(a) as being unpatentable over Mobile Commerce (a collection of articles cited in Paper #7, PTO-892, Item: U-V) and PR Newswire (Paper #7, PTO-892, Item: X), as applied to Claim 7, further in view of PR Newswire (Paper #7, PTO-892, Item: UU,**

hereinafter referred to as "PRN"), further in view of Steinberg (Paper #7, PTO-892, Item: VV).

Mobile Commerce and PR Newswire teach all the above as noted under the 103(a) rejection and further teach a) integrating smart cards for mobile commerce that serve multifunctional purposes- library card, loyalty programs, electronic purse, debit card, transport ticketing, and ID card (see Item: V, pages 1-2), b) using a smart card to sign a digest of the payment order (Gifford: see at least col. 10, lines 54 –62), and c) Transact 4 as core technology in Gifford (Item: X, pages 1-2), but do not disclose specifics on responding to purchase history requests. PR Newswire teaches Open Market's Transact 4 supporting smart cards and payment processes as they arise, and improving Transact 4 to allow sellers access to the purchase history of a given buyer (Item: UU, see at least page 3). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Mobile Commerce and PR Newswire to include purchase history access as taught by PRN, in order to provide better personalized customer service, and thereby attract more mobile customers to the online service.

Mobile Commerce, PR Newswire, and PRN teach all the above as noted under the 103(a) rejection but do not specifically disclose customer smart cards storing purchase history. Steinberg teaches smart card usage and teaches a smart card storing the complete customer purchase history (Item: VV, page 3). Therefore it would have been obvious to one of ordinary skill in the art at time of

the invention to modify the system and method of Mobile Commerce, PR Newswire, and PRN to store customer purchasing history as taught by Steinberg, in order for mobile users to conduct electronic commerce with sellers demanding purchase history information.

- 3. Claims 16 and 19 are rejected under 35 USC 103(a) as being unpatentable over Mobile Commerce (a collection of articles cited in Paper #7, PTO-892, Item: U-V), and PR Newswire (Paper #7, PTO-892, Item: X), as applied to Claims 5 and 17, further in view of Meyers (Paper #7, PTO-892, Item: WW).**

Mobile Commerce and PR Newswire teach all the above as noted under the 103(a) rejection and teach a protocol for wireless applications as merging Internet content and advanced telephony services (Item: U, page 2), use of smart cards to prevent fraud, and authentication methods to identify the customer, but do not disclose voice prints for identification. Meyers teaches GTE Telecommunication Services introducing speaker identification technology available to wireless carriers that identifies wireless roamers by using a voice print rather than a numeric code. Meyers further teaches the system being well-suited for wireless applications for evaluating the authenticity of users based on a prerecorded password, voice print, and other biometric characteristics (Item: WW, pages 1-2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Mobile

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Commerce and PR Newswire to include user voice authentication as taught by Meyers, in order to enhance security and convenience to the customer, and thereby attract more customers to the service.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 703-605-4253. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'R. M. Pond', with a stylized flourish at the end.

Robert M. Pond
Primary Examiner
February 22, 2005